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10/763,415	01/26/2004	Thomas J. Mathai	58724.00003.UTL1	4541
36183 7590 11/05/2008 PAUL, HASTINGS, JANOFSKY & WALKER LLP 875 15th Street, NW Washington, DC 20005				
EXAMINER				
REFAI, RAMSEY				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/763,415

Applicant(s)

MATHAI ET AL.

Examiner

Ramsey Refai

Art Unit

3627

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 11-16 is/are pending in the application.
- 4a) Of the above claim(s) 15 and 16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 11-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/S5108)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date 09/09/08

DETAILED ACTION

Response to Amendment

Responsive to 'Response to Election/Restriction' filed August 5, 2008. Applicant's election with traverse of Group I (**Claims 1-8 and 11-14**) is acknowledged. The traversal is on the ground(s) that there is no serious burden to examine all claims. This is not found persuasive because the inventions are distinct, each from the other. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination II has separate utility such as activating a session to facilitate purchase of items offered via public and private communication networks, wherein said public and private communications network utilizes a transmission control protocol and Internet protocol communications protocol (TCP/IP) and a transaction capabilities application part channel protocol (TCAP), which is not required by subcombination I. The claims are also classified in different classes and would therefore required different field of search. The requirement is still deemed proper and is therefore made FINAL.

Claim 15 is therefore withdrawn.

Claim 16 is withdrawn for reasons noted in the Requirement for Restriction/Election mailed July 3, 2008.

In the Amendment filed April 11, 2008, claims 9-10 were canceled.

Claims 1-8 and 11-14 are now presented.

Response to Arguments

1. Applicant's arguments filed April 11, 2008 regarding pending claims 1-8 and 11-14 have been considered but are moot in view of the new ground(s) of rejection.

Information Disclosure Statement

2. The information disclosure statement (IDS) submitted on September 9, 2008 is being considered by the examiner.

Specification

3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-8 and 11-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 1 has been amended to include the limitations **"routing said request over a transmission control protocol and Internet protocol communications protocol (TCP/IP) network and a signaling system 7 (SS7) network"** and **"wherein said telecommunications account is not associated with a communications line by which said consumer has originated said request"** which do not appear to be support by the Applicant's disclosure. Clarification of proper support is respectfully requested.

Also claim 11 has been amended to include the limitation **"a communications bridge to convert a transmission control protocol and Internet protocol communications protocol (TCP**

message to a SS7 protocol message and vice versa" which does not appear to be supported by the Applicant's disclosure. Clarification of proper support is respectfully requested.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1-8, 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Engendorf (US 6,976,008) in view of Miller et al (US 6,940,866)

8. As per claim 1, Engendorf teaches a method for facilitating online commerce comprising the steps of:

facilitating a web page displaying an item or service available for purchase;

generating, transmitting, or receiving a request from a consumer to purchase said item or service (**column 2, lines 29-30, column 5, lines 17-26; customer accesses the Internet to purchase products or services**); and

facilitating said purchase to be charged to a telecommunications account (**column 2, line 49-column 3, line 5**), wherein said telecommunications account is not associated with a communications line by which said consumer has originated said request (**column 3, lines 48-67**).

Egendorf fails to explicitly teach *routing said request over a transmission control protocol and Internet protocol communications protocol (TCP/IP) network and a signaling system 7 (SS7) network*. However, Miller et al teach routing data over a TCP/IP and SS7 network (**see at least abstract, figs 3, 7, column 7, lines 19-39**). It would have been obvious to one of ordinary skill in the art to combine the teachings of Egendorf and Miller et al because doing so would allow for the processing of web transactions by billing means implemented via SS7 networks.

9. As per claim 2, Egendorf teaches authorizing said request to determine if said purchase is authorized, wherein said purchase is charged only if said purchase is authorized (**column 4, lines 7-31, column 5, lines 35-47**).

10. As per claim 3, Egendorf teaches authorizing comprises the steps of: contacting a server servicing said telecommunications account, querying a subscriber database to determine if said consumer subscribes to a telephone account billing service, and generating a response comprising an indication of positive or negative authorization based on said query (**column 4, lines 7-31, column 5, lines 35-47**).

11. As per claim 4, Egendorf teaches determining whether an amount of said purchase is below a predetermined credit limit for said consumer (**column 6, lines 30-41; verifying that the**

amount of purchase does not exceed a credit limit is well known and inherent when using credit cards).

12. As per claim 5, Egendorf teaches wherein a value of said item or service is substantially equal to a micropayment amount **(column 2, lines 1-4).**

13. As per claim 6, Egendorf teaches remitting a portion of a full amount of said purchase to a merchant, wherein said portion is less than said full amount **(column 2, lines 33-35, column 3, lines 30-32, column 6, line 59-column 7, line 11).**

14. As per claim 7, Egendorf teaches remitting an amount to a telephone or telecommunications company servicing said telecommunications account equal to a portion of a difference between said full amount and said portion remitted to said merchant **(column 2, lines 33-35, column 3, lines 30-32, column 6, line 59-column 7, line 11).**

15. As per claim 8, Egendorf teaches wherein said step of facilitating comprises the step of: communicating with a a telephone or telecommunications company network but fails to explicitly teach communicating via a signal system 7 communications protocol **(column 1, lines 31-35, column 2, lines 59-67; SS7 communication protocol is inherent and well known in telephone networks; provides signaling).**

16. As per claim 11, it contains similar limitations as claim 1 above and therefore is rejected under the same rationale.

17. As per claim 12, Egendorf teaches wherein said authentication server validates an amount of the purchase against a predefined credit limit **(column 6, lines 30-41; verifying that the amount of purchase does not exceed a credit limit is well known and inherent when using credit cards).**

18. As per claim 13, Egendorf teaches wherein said signaling system 7 communications server receives said request via said transmission control protocol and Internet protocol

communications protocol (**column 1, lines 17-20**) and a transaction capabilities application part channel protocol (**Miller et al: column 7, line 36**).

19. As per claim 14, Egendorf teaches wherein said signaling system 7 communications server is connected to a telephone network (**column 1, lines 31-35, column 2, lines 59-67**).

Conclusion

Examiner's Note: The Examiner has cited specific citations in the reference(s) as applied to the claim(s) above for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the Applicant, in preparing their response, fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ramsey Refai whose telephone number is (571) 272-3975. The examiner can normally be reached on M-F 8:30 - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ryan Zeender can be reached on (571) 272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Ramsey Refai
October 29, 2008
/R. R./
Examiner, Art Unit 3627

/F. Ryan Zeender/

Supervisory Patent Examiner, Art Unit 3627